

**REMARKS**

Reconsideration of the present application is respectfully requested in light of the above amendments to the application and the following remarks.

**Regarding the Claims**

In response to the restriction requirement Claims 1-5 are withdrawn. Applicant confirms the verbal election of Group II, Claims 6-10 to prosecute at the present time.

Claims 6-10 have been amended. Currently pending in the application, therefore, are Claims 6-10, of which Claim 6 is independent. No new matter has been added.

Claims 6-10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Liardet (U.S. 4,864,790) in view of Hirsch (U.S. 4,849,145) and Zegler et al. (U.S. 5,567,497).

**Brief Review of the Invention**

The problem addressed by underlying the present invention is to make a tile with a layer of leather and a layer of plastic resin closely connected each other. Another goal of the invention is to attain a decorative element having a drawing or a picture of plastic resin and a background of leather. These particular goals are reached by producing at least one through hole having a predetermined shape in the layer of leather in which the plastic resin can pass through during the injection step. In this way it is possible to produce a tile having a very strong link between the two layers and at the same time to have the original aesthetic effect described above.

**Review of the Cited References****a. Liardet (U.S. Patent No. 4,864,790)**

Liardet describes a leather tile comprising a decorative upper surface and an undulating lower surface but no mention is made about holes through the two surfaces. Therefore the decorative layer is completely of leather and possible drawings can be made on the upper surface using traditional processes. Further, the object claimed in Liardet has the problem of slipping off the tile.

**b. Hirsch (U.S. Patent No. 4,849,145)**

Hirsch describes a process for the production of articles comprising at least one layer of leather and one layer of a synthetic resin connected to it. However, the subject matter of Hirsch regards watchbands and similar objects and so the technical problem intended to be solved is completely different in respect to the problem solved by the present invention.

**c. Zegler et al (U.S. Patent No. 5,567,497)**

Zegler teaches how to attain a floor covering comprising a face layer that is "fusibly compatible" with and fused to lower backing layer. The product described in Zegler ostensibly addressed in part Liardet's problems about slipping but the link between the leather layer and the plastic layer attained by the process claimed is weak. Consequently, the possibilities to have slipping events are reduced but not completely eliminated.

**Prima Facie Case of Obviousness**

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Roy*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.P.A. 1974).

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes . . .") (emphasis added); Monarch Knitting, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art,

or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 2221 U.S.P.Q. 929, 933 (C.A.F.C. 1984).

Applicant respectfully submits that the claims as amended are distinguishable over the cited combination of references. None of the references, singly or in combination, disclose the invention as presently claimed. There is no suggestion or motivation in any of these references to combine some or all of them to provide a leather tile of the present invention as claimed. It would not have been obvious to combine the teachings of the cited references and, therefore, Applicant respectfully submits that the Claims as amended are patentable over the cited art.

Some amendments and remarks contained in this document, or in other documents filed or to be filed with the US Patent Office in this case or related cases, may in the future be deemed, by a court of law or government agency of competent jurisdiction, to be narrowing amendments and/or related to patentability. Accordingly, the public is hereby advised that the applicant: (a) intends to relinquish only that claim coverage which is clearly, explicitly, precisely and unequivocally stated to be relinquished; (b) does not intend to relinquish any other claim coverage; (c) reserves the right to assert that any such amendments and/or remarks are not narrowing and/or are not related to patentability; and (d) intends to fully assert the full range of equivalents, under the Doctrine of Equivalents and otherwise, which are presently known or which may become known in the future, for each and every element of each and every claim, and for each and every claim.

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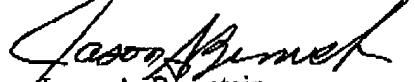
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Application No. 10/705,256  
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Should the Examiner have questions or suggestions which will put this application in line for allowance, he or she is requested to contact the undersigned attorney.

Respectfully submitted,

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